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EXAMINER

DESIR, PIERRE LOUIS

ART UNIT PAPER NUMBER

2681

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,955

Applicant(s)

DELUCA ET AL.

Examiner

Pierre-Louis Desir

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/11/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-8, 10-26, 29-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Comp, Pub. No. 2004/0203579.

Regarding claim 1, Comp discloses a cellular telephone comprising: a memory storing a telephone directory (i.e., address book database) (see fig. 2, page 2, paragraphs 12-13); a processor having access to the telephone directory stored in the memory (i.e., controller) (see fig. 2, page 2, paragraph 12); and a set of instructions capable of being executed by the processor for performing the steps of: establishing a communication link with a remote central station (i.e., the information transfer module will first call an appropriate network server in the system) (see fig. 2, page 2, paragraph 15); and transferring at least a portion of the telephone directory via the communication link to the remote central station (see fig. 2, and page 2, paragraph 14).

Regarding claim 2, Comp discloses a cellular telephone (see claim 1 rejection) wherein the processor executes the set of instructions for performing the step of instructing the remote central station to identify (see figs. 2-3, page 3, paragraph 22, and page 4, paragraph 26) and transfer at least a portion of one of a plurality of telephone directories stored within a memory of

the remote central station to at least one of a plurality of cellular telephones (see figs. 2-3, page 3, paragraph 22, and page 4, paragraph 26).

Regarding claim 3, Comp discloses a cellular telephone (see claim 2 rejection) wherein each of the plurality of telephone directories corresponds to a respective one of the plurality of cellular telephones (i.e., the address book manager is operative for managing the storage of user-specific contact information for individual users at a network storage location. The user-specific contact information is information that is transferred to the address book manager from a user device associated with the corresponding user) (see figs. 2-3, page 3, paragraph 21).

Regarding claim 4, Comp discloses a cellular telephone (see claim 2 rejection) wherein the plurality of cellular telephones includes the cellular telephone (see figs. 2-3, page 3, paragraph 21).

Regarding claim 5, Comp discloses a cellular telephone (see claim 1 rejection) wherein the communication link with the remote central station is established on a periodic basis (i.e., a user device is programmed to initiate transfers of contact information to the network at predetermined times) (see fig. 3, page 3, paragraph 22).

Regarding claim 6, Comp discloses a cellular telephone (see claim 2 rejection) wherein the step of instructing the remote central station to identify and transfer occurs on a periodic basis (i.e., the user may program the user device to make transfers at periodic intervals, wherein the information transfer module will first call an appropriate network server in the system, at the predetermined time, to request a transfer of contact information to the network. After an authentication procedure, the network server may then manage the transfer and storage of the

Art Unit: 2681

contact information to the appropriate network storage location (see fig. 2, page 2, paragraphs 15-16).

Regarding claim 7, Comp discloses a cellular telephone (see claim 1 rejection) wherein the processor executes the set of instructions for performing the step of instructing the remote central station to broadcast the telephone directory to a subset of a plurality of cellular telephones (i.e., a vendor may deliver an appropriate request to the call log manager and/or the address book manager to transfer a particular user's information to the new user device) (see fig. 3, page 4, paragraphs 25-26).

Regarding claim 8, Comp discloses a cellular telephone (see claim 1 rejection) wherein the processor executes the set of instructions for performing the steps of: receiving a message transmitted from the remote central station indicating that a telephone directory is available for transmission from the remote central station to the cellular telephone for storage within the memory of the cellular telephone (i.e., a vendor may deliver an appropriate request to the call log manager and/or the address book manager to transfer a particular user's information to the new user device) (see fig. 3, page 4, paragraph 25); and transmitting a signal to the remote central station, said signal including at least an identification code identifying the telephone directory available for transmission (i.e., a specific authorization or identification code may be required to initiate such transfer) (see fig. 3, page 4, paragraph 25).

Regarding claim 10, Comp discloses a cellular telephone (see claim 1 rejection) wherein the processor executes the set of instructions for performing the step of instructing the remote central station to store the transferred telephone directory within a memory for a particular time period (i.e., the address book manager is operative for managing the storage of user-specific

Art Unit: 2681

contact information for individual users at a network storage location. The user-specific contact information is information that is transferred to the address book manager from a user device.

Thus, the telephone directory is stored within a memory for a particular time period, which may be the time when a user purchases a new user device) (see page 3, paragraph 21, and page 4, paragraph 25).

Regarding claim 11, Comp discloses a cellular telephone (see claim 10 rejection) wherein the processor executes the set of instructions for performing the step of automatically transferring the stored telephone directory or a portion thereof to the cellular telephone after lapse of the particular time period (i.e., when a user purchases a new user device, the call log and/or contact information stored at the network storage location(s) associated with the user may be conveniently downloaded to the new user device during an initial programming of the device) (see page 4, fig. 3, paragraph 25).

Regarding claim 12, Comp discloses a cellular telephone (see claim 1 rejection), wherein the processor executes the set of instructions for performing the step of transmitting an identification code to the remote central station for identifying a telephone directory assigned the identification code and stored within the remote central station (see fig. 3, page 4, paragraphs 25-26).

Regarding claim 13, Comp discloses a cellular telephone (see claim 1 rejection) wherein the processor executes the set of instructions for performing the step of transmitting information corresponding to a subscriber of the cellular telephone to the remote central station during a registration process (in a cellular communication system, a vendor will usually program a new cellular telephone for a purchaser to, among other things, associate an identification number of

Art Unit: 2681

the telephone with a telephone number assigned to the user. This process will typically require communication with a remote network server) (see fig. 3, page 4, paragraph 25), wherein the registration process includes the step of registering the subscriber with the remote central station (see fig. 3, page 4, paragraph 25).

Regarding claim 14, Comp discloses a cellular telephone (see claim 1 rejection) wherein the processor executes the set of instructions for performing the steps of: identifying a calling party's telephone number and an entity the telephone number is assigned to, i.e., Caller ID information (i.e., the call log database may include call-related information for a predetermined number of previous calls that were placed from and/or received through the user device. The call log database will typically include the phone numbers of the other parties involved in the corresponding calls. Party names and/or other information (e.g., length of call, etc.) may also be stored. The controller may control the maintenance of the call log database or a separate control unit can be provided) (see page 2, paragraph 12); and transmitting the Caller ID information to the remote central station for storage as a telephone directory listing (see fig. 2, abstract, and page 2, paragraph 12).

Regarding claim 15, Com discloses a cellular telephone comprising: a memory storing a telephone directory (i.e., address book database) (see fig. 2, page 2, paragraphs 12-13); a processor having access to the telephone directory stored in the memory (i.e., controller) (see fig. 2, page 2, paragraph 12); and a set of instructions capable of being executed by the processor for performing the steps of: parsing Caller ID information, said Caller ID information including at least a telephone number and an entity assigned the telephone number (i.e., call-related information for a predetermined number of previous calls that were placed from and/or received

Art Unit: 2681

through the user device, which includes include the phone numbers of the other parties involved in the corresponding calls, and party names) (see page 2, paragraph 12); and storing the parsed Caller ID information as a telephone directory listing within the telephone directory (see page 2, paragraph 12).

Regarding claim 16, Comp discloses a cellular telephone (see claim 15 rejection) wherein the processor further executes the set of instructions for performing the step of transferring at least the stored telephone directory listing to a remote central station (see abstract, and page 2, paragraph 14).

Regarding claim 17, Comp discloses telephone directory management system (see abstract) comprising: a remote central station having a memory for storing a plurality of telephone directories (see fig. 3, pages 2-3, paragraph 16) each assigned an individual identification code (see fig. 3, and page 3, paragraph 19, lines 1-3) and at least one processor having access to the plurality of telephone directories stored in the memory (see fig. 3, page 2-3, paragraph 16); a plurality of cellular telephones each storing a telephone directory and having a processor for executing a set of instructions for performing (see fig. 3, and pages 2-3, paragraph 16), the steps of: establishing a communication link with the remote central station (i.e., the information transfer module will first call an appropriate network server in the system) (see fig. 2, page 2, paragraph 15); and transferring the respective telephone directories to the remote central station (see fig. 2, paragraph 14); and a set of instructions capable of being executed by the at least one processor for performing the steps of: identifying at least a portion of the telephone directory corresponding to at least one of the plurality of cellular telephones (see figs. 2-3, page 3, paragraph 22, and page 4, paragraph 26) and transferring the same to the at least one

Art Unit: 2681

of the plurality of cellular telephones (see figs. 2-3, page 3, paragraph 22, and page 4, paragraph 26).

Regarding claim 18, Comp discloses a system (see claim 17 rejection), wherein the establishing and transferring steps are performed on a periodic basis (i.e., a user device is programmed to initiate transfers of contact information to the network at predetermined times) (see fig. 3, page 3, paragraph 22).

Regarding claim 19, Comp discloses a system (see claim 17 rejection) wherein identifying and transferring steps are performed on a periodic basis (i.e., the user may program the user device to make transfers at periodic intervals, wherein the information transfer module will first call an appropriate network server in the system, at the predetermined time, to request a transfer of contact information to the network. After an authentication procedure, the network server may then manage the transfer and storage of the contact information to the appropriate network storage location (see fig. 2, page 2, paragraphs 15-16).

Regarding claim 20, Comp discloses a system (see claim 17 rejection) wherein the processor of at least one of the plurality of cellular telephones executes the set of instructions for performing the step of instructing the remote central station to broadcast a telephone directory stored within the memory to the plurality of cellular telephones (see figs. 2-3, page 3, paragraph 22, and page 4, paragraph 26).

Regarding claim 21, Comp discloses a system (see claim 17 rejection) wherein the processor executes the set of instructions for performing the steps of: receiving a message transmitted from the remote central station indicating that a telephone directory is available for transmission (i.e., a vendor may deliver an appropriate request to the call log manager and/or the

address book manager to transfer a particular user's information to the new user device) (see fig. 3, page 4, paragraph 25); and transmitting a signal to the remote central station, said signal including at least an identification code identifying the telephone directory available for transmission (i.e., a specific authorization or identification code may be required to initiate such transfer) (see fig. 3, page 4, paragraph 25).

Regarding claim 22, Comp discloses a system (see claim 17 rejection) wherein the processor executes the set of instructions for performing the steps of: identifying a calling party's telephone number and an entity the telephone number is assigned to, i.e., Caller ID information (i.e., the call log database may include call-related information for a predetermined number of previous calls that were placed from and/or received through the user device. The call log database will typically include the phone numbers of the other parties involved in the corresponding calls. Party names and/or other information (e.g., length of call, etc.) may also be stored. The controller may control the maintenance of the call log database or a separate control unit can be provided) (see page 2, paragraph 12); and transmitting the Caller ID information to the remote central station for storage as a telephone directory listing (see fig. 2, abstract, and page 2, paragraph 12).

Regarding claim 23, Comp discloses a method for managing telephone directories corresponding to a plurality of cellular telephones (see fig. 3), said method comprising the steps of: storing a plurality of telephone directories each corresponding to a respective one of the plurality of cellular telephones within a remote central station (see fig. 3, page 3, paragraphs 19-21); processing instructions received by the remote central station for identifying at least one telephone directory stored within the remote central station (i.e., the call log manager is operative

Art Unit: 2681

for maintaining a call log for individual users at a network storage location. The call log maintained for a user by the call log manager will typically include the same or similar information to that stored within a corresponding user device within the system. That is, the call log may include call-related information for a predetermined number of previous calls associated with the user) (see fig. 3, and page 3, paragraph 19); and transferring the at least one identified telephone directory to at least one of the plurality of cellular telephones (i.e., a vendor may deliver an appropriate request to the call log manager and/or the address book manager to transfer a particular user's information to the new user device) (see fig. 3, page 4, paragraphs 25-26), wherein the plurality of cellular telephones have the capability of transferring a respective telephone directory to the remote central station for storage therein (see fig. 3, page 3, paragraph 22).

Regarding claim 24, Comp discloses a method (see claim 23 rejection), further comprising the step of transmitting a message to the at least a subset of the plurality of cellular telephones indicating that a telephone directory is available for transmission to at least the subset of the plurality of cellular telephones for storage thereat (i.e., a vendor may deliver an appropriate request to the call log manager and/or the address book manager to transfer a particular user's information to the new user device) (see fig. 3, page 4, paragraphs 25-26).

Regarding claim 25, Comp discloses a method (see claim 23 rejection) further comprising the step of automatically transferring at least one telephone directory to at least a subset of the plurality of cellular telephones (see fig. 3, page 4, paragraphs 25).

Regarding claim 26, Comp discloses a method (see claim 23 rejection) further comprising the steps of: receiving Caller ID information, i.e., a calling party's telephone number

Art Unit: 2681

and an entity the telephone number is assigned to; processing the received Caller ID information to create at least one telephone directory listing i.e., the call log database may include call-related information for a predetermined number of previous calls that were placed from and/or received through the user device. The call log database will typically include the phone numbers of the other parties involved in the corresponding calls. Party names and/or other information (e.g., length of call, etc.) may also be stored. The controller may control the maintenance of the call log database or a separate control unit can be provided) (see page 2, paragraph 12); and storing the at least one telephone directory listing within the remote central station (see fig. 2, abstract, and page 2, paragraph 12).

Regarding claim 29, Comp discloses a method (see claim 23 rejection) further comprising the step of charging a fee to at least one subscriber of the plurality of cellular telephones (i.e., the call log manager only maintains call logs for users who subscribe to a call log service (e.g., for a small monthly fee)) (see page 3, paragraph 20).

Regarding claim 30, Comp discloses a method (see claim 29 rejection) wherein the step of charging is performed on a periodic basis (i.e., monthly fee) (see page 3, paragraph 20).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2681

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Comp, in view of Miyashita, Pub. No. 2002/0019225.

Comp discloses a cellular telephone as described above (see claim 1 rejection)

Although Comp discloses a cellular telephone as described, Comp fails to specifically disclose a cellular telephone wherein the processor executes the set of instructions for performing the step of instructing the remote central station to transmit the transferred telephone directory to a computing device via at least one network.

However, Miyashita discloses a cellular telephone (see abstract) wherein the processor executes the set of instructions for performing the step of instructing the remote central station to transmit the transferred telephone directory to a computing device via at least one network (i.e., the telephone directory data is uploaded into a center on the Internet from a personal computer and the telephone directory data is transmitted from the center to the mobile phone in response to a request from the mobile phone) (see page 1, paragraph 8).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation for doing so would have been to attain an enhancement in the security of the cellular phone service provider.

5. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comp, in view of Ala-Laurila, U.S. Patent No. 6246871.

Regarding claim 27, Comp discloses a method as described above (See claim 23 rejection).

Art Unit: 2681

Although Comp discloses a method wherein outgoing phone calls can be made from, and incoming phone calls may be received by a corresponding user device (see paragraph 17), Comp fails to specifically disclose a method further comprising the steps of: receiving data from a third party for transmitting to at least one subscriber of the plurality of cellular telephones; and sending the received data to the at least one subscriber of the plurality of cellular telephones.

However, Ala-Laurila discloses a method further comprising the steps of: receiving data from a third party for transmitting to at least one subscriber of the plurality of cellular telephones (see col. 3, lines 1-12); and sending the received data to the at least one subscriber of the plurality of cellular telephones (see col. 3, lines 13-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both arts to arrive at the claimed invention. A motivation for doing so would have been to ensure the proper delivery of the received message.

Regarding claim 28, Comp discloses a method as described above (See claim 27 rejection).

Although Comp discloses a method as described above, Comp fails to specifically disclose a method further comprising the step of charging a fee to the third party for performing at least the step of sending the received data.

However, Ala-Laurila discloses a method wherein a subscriber is charged for SMS transmission (see col. 2, lines 63-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both arts to arrive at the claimed invention. A motivation for doing so

Art Unit: 2681

would have been to provide a transmission method wherein the cost will be less than cellular phone air charges (see col. 2, lines 66-67).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure..

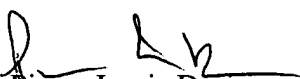
Ishigami; Masahiro, "Data transfer method and system," U.S. Patent No. 6625445.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre-Louis Desir whose telephone number is 703-605-4312.

The examiner can normally be reached on (571) 272-7799.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pierre-Louis Desir
AU 2681
04/28/2005

JEAN GELIN
PRIMARY EXAMINER
